

REMARKS

In the Office Action, the Examiner rejected claims 33-45 and 68-74. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Double Patenting Rejection

In the Office Action, the Examiner rejected claims 33-45 and 68-74 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,031,733 (hereinafter referred to as "the '733 patent"). Applicants respectfully assert that this rejection is improper.

Specifically, the present application, filed on September 14, 1998, and the '733 patent, issued on February 29, 2000, were both filed as divisional applications of U.S. Patent No. 5,944,199. During prosecution of the '199 patent, the Examiner issued a Restriction Requirement on August 18, 1998, requiring election among Groups I, II, III and IV. In the '199 patent, Applicants elected Group I and prosecuted those claims through issuance. In the '733 patent, which is a divisional of the '199 patent, Applicants pursued the subject matter previously identified by the Examiner as being restricted to Group II of the '199 patent. In the present application, Applicants pursued the subject matter previously identified by the Examiner as being restricted to Group III of the '199 patent. Applicants note that a double patenting rejection of the instant application, based on the related divisional application (the '733 patent) is improper.

Applicants refer the Examiner to MPEP 804.01, which clearly prohibits "the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent." MPEP 804.01 (Emphasis added). Thus, Applicants believe that the current double patenting rejection is improper, and Applicants respectfully request withdrawal of the double patent rejection of claims 33-45 and 68-74.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 33-38, 42, 68, 69, 71-73 under 35 U.S.C. § 102(b) as being anticipated by Chiu, U.S. Patent No. 5,239,199 (hereafter referred to as “Chiu”). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir.1990). That is, the prior art reference must show the *identical invention* “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Thus, for anticipation, the cited reference must not only disclose all of the recited features but must also disclose the *part-to-part relationships* between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir.1984). Accordingly, the Applicants need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. A *strict correspondence* between the claimed language and the cited reference must be established for a valid anticipation rejection.

Independent claim 33 recites an electronic device having, *inter alia*, “a support arranged to engage each of said packages at a point spaced above said surface to prevent movement of said packages relative to said surface, wherein said support is secured to said surface.” (Emphasis added). Independent claim 68 recites an electronic device having, *inter alia*, “at least one rail coupled to the surface, wherein the rail extends along the sides of the plurality of integrated circuit packages and is configured to engage the plurality of integrated circuit packages.” (Emphasis added). Additionally, independent claim 71 recites an electronic having, *inter alia*, “a cross piece coupled to the surface and extending over the plurality of integrated circuit packages in a direction transverse to the plurality of integrated circuit packages.” (Emphasis added).

In sharp contrast, Chiu does not disclose a support that is “secured” or “coupled” to a surface. Chiu discloses a *removable* fixture 31 that is used to “hold the devices during test and burn-in and then serves as a heat sink for the mounted array of devices.” Chiu, col. 1, lines 39-41. Further, the fixture 32 “may be removed after the leads 14 are soldered to a circuit board...the fixture 31 will generally be left over the array during testing and burn-in of the devices.” *Id.*, col. 2, lines 57-62. Thus, the fixture 31 is removable and is not secured or coupled to any surface.

The contrast between fixture 31 of Chiu and the claim features recited in independent claims 33, 68, and 71 is further illustrated by Figures 8-10 of Chiu and the corresponding text. Chiu, col. 3, lines 3-30. For example, in describing Fig. 10, Chiu states that “[h]eat sink 31a may be sprung open for securing the heat sink 15 of each device in slot 31b. The legs 31c and 31d are opened or moved apart...[e]ach leg 31c and 31d moves, for example for “a” to “b” when the legs are pulled apart.” *Id.*, 23-30. Fixture 31 is *incapable* of being secured or coupled to a surface, as the legs of the fixture 31 must be pulled apart to allow removal or insertion of devices. Thus, as described in Chiu, fixture 31 is moveable and expandable and is clearly *not* “secured” or “coupled” to a surface, i.e. mask 32 in Fig. 10. Additionally, the claims in Chiu recite a “removable fixture,” thus reinforcing the descriptions cited above. *Id.*, col. 4, lines 18-26; col. 5, lines 9-17.

For at least these reasons, Applicants respectfully submit that independent claims 33, 68, and 71, and the claims dependent therefrom, are not anticipated by Chiu. Accordingly, Applicants respectfully request the withdrawal of the Section 102 rejection of claims 33-38, 42, 68, 69, and 71-73.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 39, 40, 43-45, and 74 under 35 U.S.C. § 103(a) as being unpatentable over the Chiu reference in view of Cipolla et al., U.S. (hereafter referred to as “Cipolla”), or alternatively Shuff, (hereafter referred to as “Shuff”). Applicants

believe that these claims are allowable for the reasons set forth above, based on their dependencies on allowable independent claims. Regardless, Applicants respectfully assert that the rejection is improper.

Applicants remind the Examiner of the Examiner's duties and obligations under 37 C.F.R. §1.104, and more specifically with regard to the citation of references. Under this section, "[i]f domestic patents are cited by the examiner, their numbers, and dates, and the names of the patentee will be stated." 37 C.F.R. §1.104(d); MPEP §707.05.

In the rejection under Section 103, the Examiner did *not* provide the numbers or dates of the cited references, Cipolla or Shuff, and the references were not listed in the Notice of References Cited. As attempts to contact the Examiner were unsuccessful, Applicants respectfully believe the rejection is improper due to the omitted information regarding the cited references. If the Examiner maintains the rejection, Applicants insist the Examiner clarify his rejection and specifically cite the presently recited features and the numbers, dates, and names for each cited reference in a future non-final Office Action.

Conclusion

In view of the remarks set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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